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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/367,040	08/06/99	BROWNFIELD	A MERCK2009

IM22/1004  
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EXAMINER

AHMED, S

ART UNIT	PAPER NUMBER
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1773

DATE MAILED:

10/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/367,040

Applicant(s)  
Brownfield et al.

Examiner  
Sheeba Ahmed

Group Art Unit  
1773



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 1-10 \_\_\_\_\_ is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-10 \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 10 provides for the use of the laser-markable paper, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4238378 A.

DE 4238378 A discloses coating a substrate such a paper (*equivalent to the laser-markable paper of the claimed invention*) with a pigmented lacquer formulation coating (*thus meeting the limitation of claim 9*) pearlescent pigments based on metal-oxide coated mica flakes (*equivalent to the pearl luster pigment of the claimed invention*) wherein the flakes have a particle size of less than 20 microns (*thus meeting the limitation that the particle size is between 1 and 60 microns*) are present in the lacquer at a concentration of 2-6 wt.% (*thus meeting the limitation of claim 6*) (See Abstract). The coated papers are used for decorative purposes (*thus meeting the limitation of claim 10*). The Examiner takes the position that the coated paper and the filler disclosed in DE 4238378 A are inherently laser-markable and electrically conductive, respectively, given that the composition and structure of the coated paper and the filler disclosed in DE 4238378 A is identical to the paper and filler of the claimed invention. All limitations of the claimed invention are either inherent or disclosed in the above reference.

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3. Claims 1, 2, 4, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Yagi et al. (US 5,695,608).

Yagi et al. disclose a paper sheet (*equivalent to the laser-markable paper of the claimed invention*) and a coating layer formed thereon wherein the coating layer comprises a plate crystalline phyllosilicate compound particle having an average particle size of 5 to 50 microns (*thus meeting the limitation that the particle size is between 1 and 60 microns*) (Column 3, lines 47-54). The plate crystalline phyllosilicate compounds include mica (*equivalent to the mica of the claimed invention*), pyrophyllite and other clay minerals (Column 7, lines 39-52). The Examiner takes the position that the coated paper and the filler disclosed in DE 4238378 A are inherently laser-markable and electrically conductive, respectively, given that the composition and structure of the coated paper and the filler disclosed in DE 4238378 A is identical to the paper and filler of the claimed invention. All limitations of the claimed invention are either inherent or disclosed in the above reference.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4238378 A in view of Hosomura et al. (US 4,778,711).

DE 4238378 A, as discussed above, discloses the claimed invention but does not specifically state that the paper also comprises color pigments. However, Hosomura et al. disclose a coated paper comprising fine pigments in the coated layer wherein the pigments have an average size of 1.5 microns or less. The coated layer further comprises color pigments (Column 4, lines 22-27 and Column 6, lines 4-10). Accordingly, it would have been obvious to one having ordinary skill in the art to add color pigments to the coating lacquer disclosed in DE 4238378 A given that Hosomura et al. specifically teach that the addition of color pigments to a coated layer improves visual whiteness and adjusts the tone of the paper.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yagi et al. (US 5,695,608).

Yagi et al., as discussed above, disclose the claimed invention but do not specifically state that the coated layer comprises a mixture of inorganic platelet fillers. However, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to use a mixture of platelet fillers given the reasonable expectation of equivalent results and absent a showing of criticality.

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4238378 A in view of DE 1522686 B.


DE 4238378 A, as discussed above, discloses the claimed invention but does not specifically state that the paper also comprises light sensitive pigments. However, DE 1522686 B discloses that light sensitive pigments may be used in printing processes. Accordingly, it would have been obvious to one having ordinary skill in the art to add light sensitive pigments to the coating lacquer disclosed in DE 4238378 A given that DE 1522686 B specifically teach that the addition of light sensitive pigments produces brilliant pictures.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367.

SA  
Sheeba Ahmed  
September 28, 2000

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700